



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/757,389

01/08/2001

Frank Addante

11032/3037

6110

23838 7590 06/02/2008

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

06/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/757,389	Applicant(s) ADDANTE, FRANK	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 13-24 and 26 have been examined.

Response to Amendment

2. The Amendment filed on 3/3/08 is insufficient to overcome the prior rejection.

Election/Restrictions

3. Claim 1-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made of Group II or claims 13-24 in the reply filed on 7/31/06.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Angles (5,933,811).

Claims 13: Goldhaber discloses in a network system comprising a public network, a creative selection server connected to the public network, a content server, and a user computer that requests content pages over the public network and receives content pages and redirect commands for one or more creatives from the content server:

a server system comprising:

Art Unit: 3622

a direct connect agent connected to public network separately from the creative selection server, wherein the direct connect server receives creative selection criteria from the user computer,

generates a request for creative message as a function of the creative selection criteria;

transmits the request for creative message to the creative selection server;

and receives an identification of one or more creatives from the creative selection server and sends the identification of the one or more creatives to the user computer (Figure 10; col 15, line 46-col 16, line 5).

Note in these figures and citations from Goldhaber that item 110/agent functions as the direct connect server and that item 106/attention brokerage server functions as the creative selection server. And, note that Goldhaber discloses that either the 110/agent or 106/attention brokerage server can perform the matching (col 15, line 46-col 16, line 5).

Goldhaber does not explicitly disclose that the agent/110 is a server. However, Goldhaber discloses that agents/110 can be separate from the consumer computer and that the agents can operate from anywhere in system 100 (Fig. 1), and that system 100 can include a variety of separate servers:

“(67) In this example, the consumer interest profiles 124 may be stored at consumer computers 104 and/or at attention brokerage servers 106. In either case, the consumer's interests are represented by one or more software agents 110 that stand in for the consumer even when the consumer's computer 104 is turned off. These software agents 110 can "live" anywhere in system 100 (col 14, lines 40-50);

(2) FIG. 1 shows an example of an overall environment 100 in which the present invention may be used. Environment 100 includes a network 102 such as, for example, the Internet or "Future Net." A plurality of consumer computers 104 are connected to network 102. Also, connected to network 102 are a plurality of information servers 106 and one or more financial clearinghouse computers 108. Network 102 allows each of computers 104, 106 and 108 to communicate with other computers” (col 9, lines 30-41).

Therefore, since Goldhaber's agent is separate and can function anywhere in system 100 and since system 100 includes numerous servers, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber's agent can function on a separate server. One would have been motivated to do this in order to allow the agent better or more flexible processing capabilities.

Additionally, Examiner notes that Goldhaber discloses presenting a list of ads to the user and that the list can include titles (col 5, lines 25-35) and that the ad list can be negatively priced information where a different price is present for each ad on the list (col 7, lines 47-60; col 10, lines 38-57)

Goldhaber discloses tracking items seen by user and also indexing all content seen by users (col 8, lines 40-50).

Also, Goldhaber discloses that the user can view a title or cybercoin or thumbnail and that the full content that matches the title/cybercoin/thumbnail can be retrieved (col 16, lines 5-17).

Also, Goldhaber discloses creating an index for new ads and filing ads/ad indexes, retrieving the thumbnail/title/cybercoin of an ad when there is ad match, and then retrieving the full content of an ad when a user selects the thumbnail/title/cybercoin of an ad from an ad list (Figure 11a; col 16, lines 17-41).

Hence, Goldhaber needs a way to retrieve the full content that matches with the thumbnail of the content.

Hence, Goldhaber implies uniquely identified ads because the ads must be identified for negative pricing purposes for each unique ad, also because of the titles/thumbnails/cybercoins for ads, also because of the indexing and list of ads, also because the titles/thumbnails/cybercoins that are selected by the user need to be uniquely matched with the full content of the ad. Hence, Goldhaber implies in numerous ways and disclosures receiving an identification of one or more ads from the item 106/attention brokerage server or receiving an identification of one or more ads.

Additionally, Goldhaber, whose priority dates is December, 11, 1995 discloses that it is obvious, old and well known that advertising can be sent or linked with the content that the user requested seeing:

“(10) Because of the lack of focus inherent in mass communication, today's print and television advertising uses the concept of "linked sponsorship." "Linked sponsorship" embeds ads within or accompany (sponsor) content most likely to reach the advertisers'target audience.” (Background of the Invention, col 2, lines 21-26).

Goldhaber further discloses that advertising can be sent or linked with the content that the user requested seeing (Figure 5 and below):

“(17) FIG. 5 illustrates the concept of "linked sponsorship," and FIG. 6 illustrates the concept of "orthogonal sponsorship." As explained above, the "linked sponsorship" model shown in FIG. 5 is the traditional way in which advertisers 62 deliver their ads to consumers 64 via mass media providers 66. In the FIG. 5 model, the advertisers 62 compensate the mass media providers 66

Art Unit: 3622

to include advertisements 68 embedded in the entertainment or other content 70 being distributed by mass media to consumers 64” (col 11, lines 59-67).

Goldhaber does not explicitly disclose utilizing banner ads, html, or redirects.

However, Angles discloses advertising accompanying or associated with the content requested, banner ads, html, and redirect commands (Figure 9; col 4, lines 5-16; col 6, lines 30-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber’s obvious ads associated with content can also include banner ads and redirecting URLs/HTML commands. One would have been motivated to do this in order to better present advertising of interest to the user.

Additionally, Goldhaber further discloses creative selection criteria going from the user’s computer to a content server (Figures 1, 8, 10).

And, Angles further renders obvious:
a creative selection server (Angles, Fig 9, item 18); and
a direct connect server connected to a public network separately from the creative selection server (Angles, Figure 9, item 14 and item 18), wherein the direct connect server (Angles, Figure 9 item 14):

receives creative selection criteria from a user computer (Angles, Fig 9, item 10; also, further see Goldhaber citations for this feature); and

responsive to a user request to receive non-advertising content (Angles, Fig 9, item 10) and at least one redirect command from a content server, the redirect command configured to direct the user to the direct connect server (Angles, Fig 9, item 20; Fig 2, item 34, item 33):

generates a request for creative message as a function of the creative selection criteria (Angles, Fig 9, item 26);

transmits the request for creative message to the creative selection server (Angles, Fig 9, item 26);

receives an identification of one or more creatives from the creative selection server (Angles, Fig 9, item 30; Fig. 6, item 612); and

sends the identification of the one or more creatives to the user computer (Angles, Fig 9, item 32; Fig. 6, item 614).

Also, note that Angles discloses a content provider where the content provider has multiple servers and modules (Fig. 4, item 14; col 12, lines 27-35). And, Angles discloses standard HTML language, which includes redirect commands, (col 6, lines 30-60). Hence, the use of HTML and the multiple servers at Angles' content provider render obvious the content server and direct connect server of the Applicant's present claim 13. As presently written, Angles content provider renders obvious the content server and direct connect server of the Applicant's claim 13 since the relationship between and uniqueness of these servers remains minimally defined in the claim.

Also, Angles discloses cookies which pass a member code and/or preferences information (col 6, lines 59-65). These function as the creative selection criteria of the Applicant's claims.

Claim 14: Goldhaber discloses the request for creative message of claim 13 further defined as a function of a stored profile (col 14, lines 40-67; col 15, line 56-col 16, line 62).

Claims 15, 16, 18, 20, 22:

The prior art discloses the above.

Goldhaber further discloses targeting the user based on a variety of user information both demographic and dynamic (throughout the Goldhaber disclosure). Goldhaber discloses targeting users based on location/geographic information (col 15, lines 16-21). Goldhaber further communicating with the consumer's computer over the network or Internet (col 12, lines 14-28). Goldhaber further discloses uniquely identifying a user computer (col 16, lines 41-48).

Goldhaber further discloses not including data from which the address of a user can be derived or that a user can remain anonymous/confidential (col 15, line 55-67; col 13, lines 50-55).

Goldhaber does not explicitly disclose utilizing IP address or domain information.

However, Angles discloses utilizing the IP address and the content provider as relevant communications information and utilizing the Internet Service provider of the user as relevant criteria for selection/targeting purposes (col 7, lines 10-26; col 9, lines 20-30; col 9, lines 35-45; col 10, lines 20-34 ; col 14, lines 15-26; col 16, lines 25-38; col 17, lines 3-10).

Angles further discloses that domain name of the content server can be a criteria (col 11, lines 17-26).

Also, it is old and well known that different Internet Service Providers are going to utilize different domain names.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that IP information of domain information can be utilized as a criteria in Goldhaber's targeting based on a range of criteria including preferences and

Art Unit: 3622

geographic information. One would have been motivated to do this in order to utilize the preference and geographic information that domain names and IP addresses indicate.

Claim 17: Goldhaber discloses the request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the content server (Figs. 15, 12).

Claim 19: Goldhaber discloses the request for creative message of claim 13 further defined as a function of a search term entered by the user computer (Fig. 10, item 124).

Claims 20, 22: Goldhaber discloses the request for creative message of claim 13 further defined as a function of IP address of the content server (Fig. 10, items 140(1), 140(2); col 15, lines 16-31). Note that different content servers can have different types of content. Hence, which content server to go to can be considered as part of the selection/matching. And, it is obvious that for the agent to go to a server over the Internet that the destination server must have an address that the agent can access. One would be motivated to use a domain name or IP address in order to provide a readily available way to go to the content server of interest.

Claim 21: Goldhaber discloses the request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the direct connect server (col 14, lines 58-67).

Claim 23: Goldhaber discloses the request for creative message of claim 13 further defined as a function of a meta tag on the content server (Fig. 10; col 15, lines 16-31).

Claim 24: Goldhaber discloses the direct connect server of claim 13 further comprising a lookup table for storing category codes for use in generating a request for creative message (col 15, lines 30-47).

5. Claims 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Angles (5,933,811) in view of Hu (6,173,322).

Claim 26: The combination of the prior art discloses the above. Angles discloses where the user computer, creative selection server, and direct connect server are each separately connected to the public network (Fig. 9). While the prior art discloses a variety of server configurations, the combination of the prior art does not explicitly disclose wherein each of the user computer and the content server are connected to the public network separately from each of the direct connect server and the creative selection server. Angles does not explicitly disclose that each of the direct connect server and content server are separately connected.

However, Hu discloses that the direct connect server and content server are separately connected to the network (Abstract; col 3, lines 4-10; Figures 1, 2, 8a, 9a, 9b, 10, 11, 13).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hu's distributed content server and direct connect server using redirect commands to the prior arts content providing servers. One would have been motivated to do this in order to more efficiently provide content to the user.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are not found persuasive in regards to the independent claims. A new reference has been added to address the new features in dependent claim 26.

In regards to independent claim 13, Examiner notes the following. A personal interview was conducted on 2/7/08 which noted the following: "Applicant may further amend claims to show where a specific sequence of steps is occurring and also to show the significance of any separate servers as opposed to server functions that could be on the same server."

In the claims dated 3/3/08, the Applicant has not amended the independent claims. Applicant has amended dependent claim 26 to address some of the concerns stated in the interview. Dependent claim 26 is rejected above. Also, please note the other prior art listed below that is deemed relevant to claim 26.

In regards to the unchanged claims 13-24, as noted in the interview, Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

And, these claims 13-24 are broad and open to interpretation. For example, in independent claim 13, the function of redirect command is unclear. Is the direct connect server a special server? Are the content server and direct connect server two separate servers, owned or operated or located or connected to the public network differently? The creative selection server and direct connect server are stated as different. However, the relationship between the content server and direct connect sever is unclear. Dependent claim 26 clears up some of the relationship between these servers. However, in claims 13-24, the relationship between the

Art Unit: 3622

content server and direct connect sever remains unclear. Hence, the relationship is open to a broad interpretation.

And, the combination of the prior art discloses the features of the Applicant's claim 13. As noted in the rejection, Goldhaber discloses creative selection criteria going from the user's computer to a content server (Figures 1, 8, 10). And, Examiner notes that the combination of Goldhaber and Angles is possible and functional.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, Goldhaber discloses that it is obvious, old, and well known that content and advertisements can be presented to the user (col 1, line 50-col 2, line 22; col 2, lines 21-26). Hence, Goldhaber and Angles are analogous and related. Also, in the MPEP section 716.01(c) under the title "Attorney Arguments Cannot Take the Place of Evidence", note that objective evidence must be presented to prove inoperability. And, Teaching of a preference does not constitute a teaching away from the proposed combination under review. See *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

And, Angles discloses the features of the Applicant's claim 13 in regards to the servers as presently written in claim 13.

Angles renders obvious:

a creative selection server (Angles , Fig 9, item 18); and

Art Unit: 3622

a direct connect server connected to a public network separately from the creative selection server (Angles, Figure 9, item 14 and item 18), wherein the direct connect server (Angles, Figure 9 item 14):

receives creative selection criteria from a user computer (Angles, Fig 9, item 10; also, further see Goldhaber citations for this feature); and

responsive to a user request to receive non-advertising content (Angles, Fig 9, item 10) and at least one redirect command from a content server, the redirect command configured to direct the user to the direct connect server (Angles, Fig 9, item 20; Fig 2, item 34, item 33):

generates a request for creative message as a function of the creative selection criteria (Angles, Fig 9, item 26);

transmits the request for creative message to the creative selection server (Angles, Fig 9, item 26);

receives an identification of one or more creatives from the creative selection server (Angles, Fig 9, item 30; Fig. 6, item 612); and

sends the identification of the one or more creatives to the user computer (Angles, Fig 9, item 32; Fig. 6, item 614).

Also, note that Angles discloses a content provider where the content provider has multiple servers and modules (Fig. 4, item 14; col 12, lines 27-35). And, Angles discloses standard HTML language, which includes redirect commands, (col 6, lines 30-60). Hence, the use of HTML and the multiple servers at Angles' content provider render obvious the content server and direct connect server of the Applicant's present claim 13. As presently written, Angles content provider renders obvious the content server and direct connect server of the

Art Unit: 3622

Applicant's claim 13 since the relationship between and uniqueness of these servers remains minimally defined in the claim.

Also, Angles discloses cookies which pass a member code and/or preferences information (col 6, lines 59-65). These function as the creative selection criteria of the Applicant's claims.

Hence, the combination of the prior art renders obvious the features of the Applicant's claims.

Examiner further notes that when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) McCanne 20050010653 at Abstract; Primak 20020010783 at (claim 13); Joffe (6185619) at (Det Paragraph 58); and Lewis 6553376 at (Det 28) disclose relevant features to distributing/spreading server loads across content servers when content is requested. These also disclose relevant features to redirecting and direct connect servers.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

/Arthur Duran/
Primary Examiner, Art Unit 3622
5/29/2008